

### REMARKS

Claims 1-34 are pending, with claims 1, 14, 21, and 25 being independent. Claims 33 and 34 have been added by this amendment.

This Reply first addresses the § 102(e) rejection of claims 1-13 and 21, then the § 103(a) rejection of claims 14-20 and 25-32, and finally the § 103(a) rejection of claims 22-24.

#### Claims 1-13 and 21

Claims 1-13 and 21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Wical (U.S. 5,940,821). As an initial matter, and as discussed with Supervisory Examiner Metjahic on August 14, 2003, the correct patent number for Wical is U.S. 5,940,821, as noted above and distinguished from the notation provided in the Office Action text.

Applicants have amended claims 1 and 21 to obviate this rejection.

As amended, claims 1 and 21 recite, a method (claim 1) and a computer program (claim 21) for performing a category search to identify categories of items that relate to a search term that includes, inter alia, receiving at least one search term, where the search term includes at least one search term word. The search term is compared with a hierarchy of category identifiers to determine whether matches exist by comparing the search term word with one or more words in the hierarchy of category identifiers. The search term word is compared with terms related to one or more categories to determine whether matches exist. At least a category identifier is displayed based on the matches that are determine to exist between the search term word and the words of the hierarchy of category identifiers and between the search term word and the terms related to one or more categories. Applicants request withdrawal and reconsideration of the rejection because Wical fails to describe or suggest a method/program for performing a category search that performs the recited two comparisons to identify matches of the search term by matching the search term word with one or more words in the hierarchy of category identifiers and by matching the search term word with the terms related to one or more categories.

Instead, Wical discloses a search and retrieval system that "utilizes a classification system, but does not require matching words of the search query with words in the name strings

of the categories." Wical, col. 2, lines 36-40 (emphasis added). In fact, through this statement, Wical clearly teaches away from matching a word of the search term against words of the hierarchy of category identifiers and from matching a word of the search term against the terms related to one or more categories. Moreover, the system that is disclosed in Wical is fundamentally different than the features recited in amended claims 1 and 21. In Wical, words of the search query are not matched with a hierarchy of category identifiers and the words of the search query are not matched with terms related to one or more categories.

For at least these reasons, Applicants respectfully request the withdrawal of the § 102(e) rejection of claims 1 and 21, and their dependent claims 2-13.

#### **Claims 14-20 and 25-32**

Claims 14-20 and 25-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wical in view of Snow et al. (U.S. 6,055,540). Applicants respectfully traverse § 103(a) rejection of claims 14-20 and 25-32.

Claims 14 and 25 recite a method (claim 14) and a computer program (claim 25) for performing a search that includes, inter alia, comparing the search term with a list of recommended items to determine whether matches exist and comparing the search term with previously performed searches to determine whether matches exist. Applicants request withdrawal and reconsideration of the rejection because Wical and Snow, either alone or in combination, do not disclose or suggest these features. Wical is not relied upon in the office action to support a showing of these features, as acknowledged by the Examiner during the previous in-person interview.

Snow fails to remedy the above-noted Wical shortcomings (failing to disclose comparing the search term with a list of recommended items to determine whether matches exist and failing to disclose comparing the search term with previously performed search to determine whether matches exist). The Office Action points to Snow col. 7, line 66 to col. 8, line 15 to support the feature of comparing the search term with a list of recommended items to determine whether matches exist. However, this relied upon portion of Snow, as well as the rest of the Snow,

simply does not disclose comparing a search term with a list of recommended items to determine whether matches exist. Instead, the relied upon section of Snow discloses that during a user query, which includes a user selected category, a directed search is performed. In this directed search, the search terms are compared to each of the relevant document vectors created by the document indexing of the document directory hierarchy. After comparing the search terms to each of the relevant documents, a list of document directory paths is obtained, where each of the document directory paths include a matching document name and a directory path corresponding to a matching document. This list of document directory paths that is obtained is product of the comparison between the search terms and each of the relevant document vectors. This differs from what is recited in claim 14, namely, the process of comparing the search term with a list of recommended items to determine whether matches exist. In Snow, no comparison between the search term and a list of recommended items is ever performed, but instead a list of document directory paths is obtained as a result of the comparison.

Moreover, the Office Action relies upon Snow col. 8, lines 25-38 to support the feature of comparing the search term with previously performed searches to determine whether matches exist. The relied upon portion of Snow, as well as the rest of Snow, simply does not disclose performing a comparison of the search term with previously performed searches to determine whether matches exist. The relied upon portion of Snow discloses a user query, which does not include a user selected category, that Snow calls an "undirected search." In this undirected search, the search terms are compared to each of the relevant document vectors created by the document indexing of the document directory hierarchy. After the search is performed, a list of document directory paths is obtained. Each of the document directory paths includes a matching document name and a directory path corresponding to a matching document and the relevant documents are ranked according to relevance using a statistical ranking. Then, matching category names are obtained. Nowhere does this relied upon section of Snow disclose comparing the search term with previously performed searches to determine whether matches exist.

Thus, the combination of Wical and Snow fails to describe or suggest the features of claims 14 and 25, or the features of their dependent claims 15-20 and 26-32. Therefore, Applicants respectfully request withdrawal of § 103(a) rejection of claims 14-20 and 25-32.

#### **Claims 22-24**

Claims 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wical in view of Snow. Claims 22-24 depend from independent claim 21. For at least the reasons discussed above with respect to claim 21, Wical fails to describe or suggest the features of claim 21. Snow is not relied upon in the Office Action nor can it properly be said to remedy the above-noted Wical shortcomings (teaching away from matching against a hierarchy of category identifiers). Thus, the combination of Wical and Snow fails to describe or suggest the claim 21 features or the features of its dependent claims 22-24. Moreover, in view of the respective dependence upon claim 21, Applicants respectfully request the withdrawal of the § 103(a) rejection of claims 22-24.

#### **Claims 33 and 34**

New claims 33 and 34 depend from independent claims 14 and 25, respectively. For at least this reason, Wical and Snow, either alone or in combination, fail to describe or suggest the features of claims 33 and 34. Applicants respectfully request that new claims 33 and 34 be allowed.

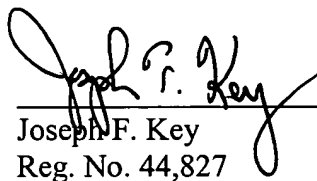
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No fee is believed to be due at this time. However, during prosecution of this case please apply any deficiencies or credits to deposit account 06-1050.

Respectfully submitted,

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